



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/120,030      07/21/98      GOLDSTEIN

B      1102870-0456

EXAMINER

HM12/0914

WHITE & CASE  
PATENT DEPARTMENT  
1155 AVENUE OF THE AMERICAS  
NEW YORK NY 10036

DORIN, M  
ART UNIT

PAPER NUMBER

8

1631  
DATE MAILED:

09/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

**Advisory Action**Application No.  
**09/120,030**Applicant  
**Goldstein et al.**Examiner  
**Michael Borin**Group Art Unit  
**1631****THE PERIOD FOR RESPONSE: [check only a) or b)]**a) ☐ expires \_\_\_\_\_ months from the mailing date of the final rejection.b) ☒ expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

☐ Appellant's Brief is due two months from the date of the Notice of Appeal filed on \_\_\_\_\_ (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on Jun 16, 2000 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

☐ The proposed amendment(s):

☐ will be entered upon filing of a Notice of Appeal and an Appeal Brief.

☐ will not be entered because:

☐ they raise new issues that would require further consideration and/or search. (See note below).

☐ they raise the issue of new matter. (See note below).

☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.

☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

☐ Applicant's response has overcome the following rejection(s): \_\_\_\_\_

☐ Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

☒ The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached

☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

☒ For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: \_\_\_\_\_

Claims objected to: \_\_\_\_\_

Claims rejected: 4, 5, 28, 29, and 32-55

☐ The proposed drawing correction filed on \_\_\_\_\_ ☐ has ☐ has not been approved by the Examiner.

☐ Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

☐ Other

**MICHAEL BORIN  
PRIMARY EXAMINER  
ART UNIT 1631**

Art Unit: 1631

## **DETAILED ACTION**

### ***Status of Claims***

1. Amendment filed 06/16/00 is acknowledged. Claims 4,5, 28,29,32-55 are pending.
2. Applicant traverses finality of the previous Office action arguing that the Examiner has essentially used the same arguments as in the preceding Office Action, and that amendments to the claims cannot be said to constitute amendments necessitating new grounds of rejections. The cited arguments only seem to confirm validity of the finality of the previous Office action. Examiner made the statement that applicant's amendment necessitated the new grounds of rejections to reflect that rejections under 35 U.S.C 102 were converted to obviousness rejections under 35 U.S.C. 103(a), and that the rejections now addressed newly submitted claims. Therefore, the finality of the previous Office action is maintained.
3. Applicants arguments have been considered but were not deemed persuasive. Examiner maintains that it would have been obvious to be motivated to use recombinant lysostaphin instead of the natural lysostaphin, because of known advantages of the use recombinant peptides (such as simplicity of their preparation).

It should be noted that Applicants have traversed the Oldham reference pointing to the differences between the claims and the disclosure in the reference. Applicant is respectfully reminded that the rejection is under 35 USC103 and that unobviousness cannot be established by attacking the references individually when the rejection is based on the combination of the references. It has been well established that the test for

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combining references is not what individual references themselves suggest but what the combination of disclosures taken as a whole would suggest to one of ordinary skill in the art. *In re McLaughlin*, 170 USPQ 209 (CCPA 1970). In the instant case the reason for citing Oldham reference was to demonstrate that , in addition to the general understanding of advantages of the use of recombinant peptides over their natural analogs, prior art does demonstrate that lysostaphin has been produced recombinantly, and that its high antimicrobial activity are similar to the natural product.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Borin whose telephone number is (703) 305-4506. Dr. Borin can normally be reached between the hours of 8:30 A.M. to 5:00 P.M. EST Monday to Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Michael Woodward, can be reached on (703) 308-4028. The fax telephone number for this group is (703) 305-3014.

Any inquiry of a general nature or relating the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

9. The Art Unit of your application in the PTO has changed. To aid any papers for this application, all further correspondent should be directed to Art Unit 1631.

March 7, 2000

mlb



**MICHAEL BORIN, PH.D.**  
**PATENT EXAMINER**